

REMARKS

1.) Claim Amendments

Claims 26-30, 33-35, 40, and 42 are pending in the application. Claims 36-39 and 41 were previously withdrawn from consideration in response to the Examiner's restriction requirement. The Applicants have made minor amendments to claims 26 and 40. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

2.) Claim Rejections – 35 U.S.C. § 102

On page 4 of the Office Action, the Examiner rejected claims 26-30, 33-35, 40, and 42 under 35 U.S.C. 102(e) as being anticipated by McCall et al. (US 6,321,984B1). The Applicant contends that McCall '984 is disqualified as prior art because the present application is a continuing application from McCall '984 and the inventorship is the same.

As shown on the enclosed PALM Data Sheet, the Applicants' Petition to add G. Randy Nicholson as an inventor on the McCall '984 patent has been approved and processed. Thus, McCall '984 is disqualified as prior art. Therefore, the withdrawal of the rejection and the allowance of claims 26-30, 33-35, 40, and 42 are respectfully requested.

On page 10 of the Office Action, the Examiner rejected claims 26-30 and 33-35 under 35 U.S.C. 102(e) as being anticipated by Pete Hisey in "Storming the Store Card Gates" (Hisey), an article published in July 1997. The Applicants respectfully disagree because Hisey was published after the earliest priority date claimed in the present application.

The present application claims priority back to February 25, 1997, when provisional application no. 60/039,007 was filed. That provisional application was the basis for non-provisional application no. 09/026,634, now issued as US 6,112,981 (McCall '981). The Applicants note that McCall '981 discloses the invention as claimed in independent claims 26 and 34 in Example C (Col. 6, lines 20-32). Thus,

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the subject matter of the present application predates Hisey. Therefore, the withdrawal of the rejection and the allowance of claims 26-30 and 33-35 are respectfully requested.

Also on page 10 of the Office Action, the Examiner rejected claims 40 and 42 under 35 U.S.C. 102(b) as being anticipated by JP 2217998 (Yoshimitsu). The Applicants respectfully disagree.

Yoshimitsu discloses a method of stimulating sales in a gas station by providing a discount on a non-fuel product when fuel is purchased, or vice versa. Unlike the claimed invention, the Yoshimitsu method is utilized during a single visit to the gas station. The customer is informed of the potential discount when he is purchasing the first product so that he is motivated to purchase the discounted product in the same transaction. When the customer purchases both products in the same transaction, the purchase price of the discounted product is automatically reduced.

Claim 40 includes several limitations that are not disclosed or suggested by Yoshimitsu. For example, claim 40 recites:

(1) *assigning a customer identification to the customer.* Yoshimitsu does not disclose or suggest this step because there is no need for a customer identification when the discount is triggered solely by the purchase of a triggering product in the same transaction.

(2) *storing the first discount amount in a discounts issued database that associates the first discount amount with the customer identification.* Yoshimitsu does not disclose or suggest this step because there is no need to store the discount information in a database when the discount is triggered solely by the purchase of a triggering product in the same transaction.

(3) *inputting by the customer in a subsequent transaction, the customer identification.* Yoshimitsu does not disclose or suggest a customer identification, and specifically teaches away from a method that links to a subsequent transaction. Yoshimitsu is strictly limited to a single transaction.

(4) *retrieving the first discount amount from the discounts issued database.* Yoshimitsu does not disclose or suggest this step because there is no disclosure or suggestion of storing the discount information in a database in the first place.

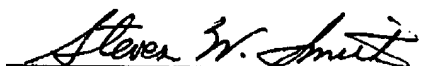
For all the above reasons, the withdrawal of the rejection and the allowance of claim 40 and dependent claim 42 are respectfully requested.

The Applicants further note that dependent claim 42 adds the limitation that the desired product or service is gasoline, and the first discount amount is a discount on the price-per-unit-volume of gasoline. Although Yoshimitsu discloses discounting fuel, there is no suggestion that the discount is handled on a price-per-unit basis. When Yoshimitsu was published in 1990, there was no way to automatically reduce the price-per-unit on the fuel dispenser. Therefore, one skilled in the art would interpret Yoshimitsu's discount as being a discount off the total price of the fuel purchase.

CONCLUSION

For all the above reasons, the Applicant respectfully requests the allowance of claims 26-30, 33-35, 40, and 42, and the passing of this application to issue.

Respectfully submitted,



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